

**REMARKS**

**OBJECTION TO THE SPECIFICATION AND DRAWING**

The Examiner has objected to the Abstract for containing improper language and format. Applicant has corrected the abstract as requested.

The Examiner also objected to the specification for containing the word “cheramic.” Applicant here amends the typographical error to “ceramic.”

Furthermore, the Examiner objected to the drawing under 37 C.F.R. § 1.84 (p) (5) because the description for reference number (9) is not provided for. In response, Applicant amends the specification to describe the (9) the proximal surface.

In view of the amendments, Applicant requests that the Office withdraws the objections.

**INDEFINITENESS REJECTION AND OBJECTION**

Claims 1-16 are pending in this application. The Examiner has rejected claims 10, 11, 15-16 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for lacking sufficient antecedent basis. The Examiner also objected to the typographical error “too the” in claim 3. Applicant here amends these claims to provide antecedent basis and corrects the typographical error to “tooth.” No new matter has been added by these amendments. A withdrawal to the rejection and objection is therefore requested.

**NOVELTY REJECTION**

The Examiner rejected claims 1-6, 10 and 12-16 under 35 U.S.C. § 102 (b) as allegedly being anticipated by *Hagne* (U.S. Pat. No. 5,567,156). In this response, Applicant amends claim 1, 5, 6, and 16 to specify that the vertical edges have “grooves”. Applicant submits that *Hagne* fails to disclose inserts having substantially vertical edges having a groove along at least a portion of the edge,” Instead, *Hagne* discloses only inclined surfaces.

The Examiner also alleged that *Hagne* (Column 5, line 23-51) discloses the shapable resin being applied into inclinations on *Hagne*'s insert. Applicant respectfully traverses this statement. *Hagne* discloses (see Column 5, line 46-47) that "*the inlay 1 is pressed down into cavity 20 until its circumferential surface makes firm contact with the opening of the cavity*". This clearly indicates that the edges of the "circumferential surface" are in direct contact with the surrounding edges of the prepared cavity.

The Examiner also rejected claims 1-7 and 10 under 35 U.S.C § 102 (b) as being anticipated by *Dieter* (DE 19812982). Applicant submits that *Dieter* fails to disclose inserts having substantially vertical edges having a groove along at least a portion of the edge. Figure 7 from *Dieter*, which is reproduced in the Official Action is an inclined surface, but not a groove.

Applicant submits that neither the inserts disclosed by *Hagne* nor those by *Dieter* have grooves along at least a portion of the edge of the exposed surface, making a narrow and shallow space surrounding the exposed surface, which can be suitably filled with a shapeable resin to create a smooth continuous surface of the exposed surface and the adjacent tooth surface. If the insert has no such groove, the exposed surface may not be in perfect level with the adjacent tooth surface due to protruding edges of the exposed surface of the insert and/or of the adjacent edges of the cavity. This is discussed in some detail in the application on page 2, lines 15-29.

Applicant therefore requests the withdrawal of this rejection in light of the amendments to the claims.

#### OBVIOUSNESS REJECTION

The Examiner rejected claims 8, 9 and 11 under 35 U.S.C. § 103 (a) as allegedly being obvious over *Hagne*. Applicant respectfully traverses this rejection. As set forth

earlier, *Hagne* fails to teach or suggest a groove as presently claimed in 8, 9 and 11.

Applicant therefore requests a withdrawal of this rejection.

The Examiner also rejected claim 16 under 35 U.S.C. § 103 (a) as allegedly being obvious over *Hagne* in view of *Jonsson* (WO 02/34154) and *Lee* (U.S. Pat. No.5,695,340). Applicant respectfully traverses this rejection. As the Examiner has acknowledged, neither *Dieter* nor *Jonsson* teach or suggest applying shapable cement material to the grooves located on the interfaces between said insert and the prepared cavity. In addition, Applicant also asserts that such step is absent in the teaching of *Lee*. Accordingly, none of the raised references teaches nor suggests applying shapable cement material into the grooves. Therefore, withdrawal of this rejection is requested.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the phone number of the undersigned below.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a three (3) month extension of time for filing a reply to the outstanding Office Action and submit the required \$525.00 extension fee herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C

Dated: January 22, 2007

By: 

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JAC/pw

Attachments

1. A separate page of Abstract as amended.